

REMARKS

This paper is presented pursuant to 37 CFR §1.143 and in response to the non-final official action dated December 7, 2009, wherein the Patent Office set forth a restriction requirement between the following groups of claims:

Group I, claims 1-7, drawn to a method; and

Group II, claims 8-26, drawn to an apparatus.

Initially, the applicants respectfully submit that the application, as amended by the Preliminary Amendment dated May 11, 2006, includes 35 total claims, and not 26. Claims 1-7 and 27-31 are directed to a method, and claims 8-26 and 32-35 are directed to an apparatus. Accordingly, the applicants believe the restriction requirement was intended to be cast between the following groups of claims:

Group I, claims 1-7 and 27-31, drawn to a method; and

Group II, claims 8-26 and 32-35, drawn to an apparatus.

As will be detailed more thoroughly below, the applicants hereby provisionally elect Group II, claims 8-26 and 32-35, for continued prosecution, *with traverse*, thereby preserving the right to petition the Commissioner for review of any final restriction requirement.

A. The Restriction

As basis for the restriction, the official action asserts that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reason: "The two groups do recite distinct limitations."

B. The Standard for Requiring Restriction to One of Two Groups of Claims Has Not Been Met

The applicants respectfully submit that the official action does not provide an adequate basis for the restriction imposed between the claims of the two groups.

Because this application is the U.S. national phase of an international (PCT) application, unity of invention practice—not restriction practice—is applicable. See

MPEP § 1893.03(d) (8th Ed., Rev. 5, Aug. 2006). Accordingly, the standard for making a lack of unity-of-invention finding requires a showing by the Patent Office that (a) there are different groups of claims present in one application, and (b) why each of the groups lacks unity relative to each other group, specifically describing the unique special technical feature in each group. *Id.* A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature that defines the contribution, which each claimed invention, when considered as a whole, makes over the prior art. The examiner's attention is directed to the examples in Annex B, Part 2 of the PCT Administrative Instructions as amended July 1, 1992, contained in Appendix A1 of the MPEP (8th ed., Rev. 2, May 2004).

While the action has set forth two different groups of claims, it is respectfully submitted that the action provides neither an adequate explanation as to why the claims of each group lack unity relative to the claims of each other group, nor an adequate explanation specifically describing the unique special technical feature in each group. Both explanations are required to support the lack of unity-of-invention rejection. MPEP § 1893.03(d). Absent some assessment of the patentability of the claims over the prior art or over one another, the Patent Office has not met its burden of establishing that the two groups of inventions lack a single, general inventive concept. In contravention of Rule 13.1, the official action fails to identify any prior art to support its conclusion that the claims lack unity of invention. Furthermore, the international searching authority has not objected to the unity of invention. Accordingly, the applicants respectfully request reconsideration and withdrawal of the objection on the basis that no adequate case for restriction has been made.

C. Groups Relate to Single General Inventive Concept

Furthermore, the applicants request withdrawal of the restriction requirement because the claims of Group I and the claims of Group II relate to a single general inventive concept in that there is a technical relationship between the subject matter claimed in each alleged Group involving one or more of the same corresponding special technical features.

Specifically, in accordance with 37 CFR §1.475(b)(4), the applicants submit that Group I, as represented by independent claim 1, constitutes a process and Group II, as represented by independent claim 8, constitutes an apparatus or means specifically designed for carrying out said process. That is, each of independent claims 1 and 8 recites a special technical feature including a ventilation device, a control or regulation device, and a filling- and/or charge-amount monitoring device arranged such that at least one characteristic parameter related to an amount of fluid incident on a fan of the ventilation device is determined and/or evaluated. The applicants submit that at least these corresponding special technical features so link Groups I and II to satisfy the unity of invention standard. Moreover, while this indicates that the unity of invention standard has been satisfied, it in no way implies that the apparatus could not be used to carry out another process, or whether the process could be carried out by another apparatus, as indicated by MPEP §1893.03(d).

D. Admissions Concerning the Patentability of the Claims Result if the Patent Office Imposes Any Restriction Requirement¹

By imposing restriction among the two groups of claims, the Patent Office makes numerous admissions that may compel it to issue multiple patents.

¹ 35 USC § 372(a) provides that “all questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the cases of national applications regularly filed in the Patent and Trademark Office.” Accordingly, the effects of restricting claims in the Patent Office are the same whether the unity of invention standard of PCT Rule 13 or the independent and distinct inventions standard of 35 USC § 121 is applied as the basis for restriction.

Specifically, if the two-way restriction requirement is maintained, then the Patent Office admits that:

- (1) The Group I method is patentable over a disclosure of the Group II apparatus; and
- (2) The Group II apparatus is patentable over a disclosure of the Group I method.

See, e.g., MPEP § 802.01 (8th Ed., Rev. 5, Aug. 2006). These admissions are necessary to the Patent Office's entry of the restriction requirement and may be relied upon by the applicants during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the Patent Office is not making these admissions regarding patentability, then the restriction requirement should be withdrawn or reexamined under 35 USC § 121 pursuant to the provisions of 35 USC § 372(b)(2).²

The restriction requirement should also be withdrawn because the restriction may present potential double patenting. According to the MPEP, the patent statute (e.g., 35 USC § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a **heavy burden** on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

² 35 USC § 372(b)(2) states that "the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of this treaty and the Regulations."

See MPEP § 804.01 (8th Ed., Rev. 5, Aug. 2006) (emphasis added). The applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

E. Search and Examination of the Claims in the Various Groups Can Be Made Without Serious Burden on the Patent Office

According to the MPEP, a requirement for restriction between multiple inventions is proper only when the Patent Office establishes (1) that the claimed inventions are independent or distinct, and (2) there would be a serious burden on the examiner if restriction were not required:

If the search and examination of all the claims in an application can be made without serious burden, ***the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.***

MPEP § 803 (8th Ed., Rev. 5, Aug. 2006) (emphasis added).

The applicant acknowledges that “a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02 [(8th Ed., Rev. 5, Aug. 2006)].” MPEP § 803(II). The official action, however, alleges no such burden.

The claims corresponding to Groups I and II are concerned with similar subject matter. Accordingly, a complete search directed to the subject matter recited in the claims of either of the identified groups necessitates a search directed to the subject matter recited in the claims of the other group. The applicants fail to see how separate searches would be necessary.

Because search and examination of the entire application can be made without serious burden on the Patent Office, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute claims directed to the method and the apparatus in separate applications. Furthermore, if the restriction requirement is maintained, the applicants will likely incur additional

prosecution costs associated with filing one or more divisional applications, and the Patent Office will be required to perform duplicative searches and expense duplicative resources. Thus, withdrawal of the restriction requirement will actually reduce the burden on the Patent Office and on the applicants.

Accordingly, the applicants respectfully request withdrawal of the restriction requirement for these additional reasons.

F. Provisional Election

In accordance with 37 CFR 1.143, the applicants hereby provisionally elect to prosecute Group II, claims 8-26 and 32-35, for continued prosecution, *with traverse*. In making this provisional election, the applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may, if required, choose to pursue them either by petition for further review or in a divisional application in the event the Office chooses to make the restriction requirement final.

Should the restriction requirement be deemed final and the subject matter recited in the Group II claims be found allowable, the applicants respectfully request that the subject matter recited in the non-elected Group I claims be automatically rejoined.

CONCLUSION

Should the examiner wish to discuss any of the foregoing, or any matter of form or procedure related to the present application, the examiner is urged to contact the undersigned at (312) 474-6300.

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Respectfully submitted,

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